

Appl. No. 10/718,973
Reply dated October 31, 2005
Reply to Office Action of May 31, 2005

REMARKS

Claims 1-8 and 10-20 are presented for Examiner Boykin's consideration. No claims are amended by this paper and no new claims are added.

Pursuant to 37 C.F.R. § 1.111, reconsideration of the present application in view of the following remarks is respectfully requested.

Applicant thanks Examiner Boykin for including in the Office Action mailed May 31, 2005 a signed copy of the initialed Form PTO-1449 sent with Applicant's Information Disclosure Statement mailed February 10, 2005.

Claims Rejection, 35 U.S.C. §102(e), Japanese Pub. No JP 2004-315659

In the Office Action mailed May 31, 2005, claims 1-8 and 10-20 were rejected under 35 U.S.C. §102(e) as allegedly being anticipated by and thus unpatentable over Japanese Patent Office publication number JP 2004-315659. This rejection is respectfully **traversed** on the grounds that this publication of the Japanese Patent Office does not appear to be available as prior art under 35 U.S.C. §102(e). Please see 35 U.S.C. §102(e) and/or M.P.E.P. § 706.02(f)(1). As noted in M.P.E.P. § 706.02(f)(1)(A), "The potential reference must be a U.S. patent, a U.S. application publication (35 U.S.C. 122(b)) or a WIPO publication of an international application under PCT Article 21(2) in order to apply the reference under 35 U.S.C. 102(e)". Applicant therefore respectfully submits that this rejection under 35 U.S.C. §102(e) over Japanese Patent Office publication number JP 2004-315659 should be withdrawn. Because Applicant believes Japanese Patent Office publication number JP 2004-315659 is not properly available as art under 35 U.S.C. §102(e), no discussion of the substance of this rejection is provided herewith.

Claims Rejection, 35 U.S.C. §102(e), U.S. Pub. No 2003/0162013 to Topolkaraev et al.

In the Office Action mailed May 31, 2005, claims 1-8 and 10-20 were rejected under 35 U.S.C. §102(e) as allegedly being anticipated by and thus unpatentable over US Patent Application Publication Number 2003/0162013 to Topolkaraev et al. (hereinafter

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"Topolkaraev et al."). This rejection is respectfully **traversed** to the extent it may apply to the currently presented claims, as described in the remarks below.

This rejection appears to be the same rejection as was presented by the Office in the Office Action mailed September 23, 2004, except that reference to claim 9 (canceled in Applicant's paper filed January 24, 2005) was omitted in the Office Action mailed May 31, 2005. Therefore, Applicant's remarks and arguments below are essentially the same as those filed January 24, 2005. These remarks were not discussed in the Office Action mailed May 31, 2005, except that the form PTOL-326 does state that the Action is responsive to Applicant's communication filed January 24, 2005.

Applicant again submits that the Topolkaraev et al. reference does not properly anticipate the invention as claimed. The invention as presently claimed in claim 1 is directed to a composition for a biodegradable, breathable film comprising a biodegradable polyester, a biodegradable copolyester and at least one filler, and wherein the weight ratio of the polyester to the copolyester ranges from about 1:9 to about 9:1. The invention as claimed in claim 10 is directed to a biodegradable and breathable film comprising a biodegradable polyester, a biodegradable copolyester and a filler, and wherein the weight ratio of the polyester to the copolyester ranges from about 1:9 to about 9:1.

As noted in the Office Action, the Topolkaraev et al. reference is directed to personal care products including biodegradable films, where the biodegradable films include a biodegradable polymer and a water-soluble polymer. As stated in Topolkaraev et al., the biodegradable polymer may be such as a biodegradable aliphatic polyester and the water-soluble may be such as polyethylene oxide or polyethylene glycol, or copolymers thereof. The Office Action directed attention to the film compositions described on pages 1-6 and specifically Tables 3 and 4 of the Topolkaraev et al. reference and stated that Topolkaraev et al. anticipates all claims of the Application. However, the Applicant respectfully disagrees, as explained below.

According to M.P.E.P. §2131, in order to anticipate a claim, the reference must teach every element of the claim. The claims of the invention require the composition and film to comprise at least a biodegradable polyester and a biodegradable copolyester, along with

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at least one filler, and the weight ratio of the polyester to the copolyester ranges from about 1:9 to about 9:1. The Topolkaraev et al. reference, on the other hand, appears to teach a film having a biodegradable polyester (similar to the application claims) which is mixed or blended in all cases with a water soluble polymer such as the polyethylene glycol or polyethylene oxide. These polyethylene glycol or polyethylene oxide water soluble polymers to be mixed or blended with the biodegradable polyester in Topolkaraev et al. are polyethers, rather than being biodegradable copolyesters as is required in the claims. In addition, there is no teaching in Topolkaraev et al. of a film or film composition comprising a biodegradable polyester with a biodegradable copolyester in the required weight ratios of about 1:9 to about 9:1 polyester to copolyester weight ratio. For at least these reasons, the Applicant submits that all of the elements of independent claims 1 and 10 are not taught by the Topolkaraev et al. reference.

The Applicant believes the dependent claims 2-8 and 11-20 further patentably define the invention over the cited art. As examples, with respect to the polylactic acid polymers listed in claim 5, the Office Action stated that Topolkaraev et al. states that fibers from polylactic acid polymers are known. However, Applicant respectfully submits that this statement regarding fibers made from polylactic acid is not an anticipatory teaching that the biodegradable polyester in the Applicant's biodegradable film composition may be polylactic acid, and particularly does not teach the combination of a polylactic acid polymer as the biodegradable polyester along with a biodegradable copolyester, as required by the combination of claims 5, 2 and 1.

With respect to the additional element of a polymer compatibilizer in claim 6, the Office Action again states, "Note that the uv light stabilizer as discussed in applicants specification on page provides the compatibilizer to the composition." However, Applicant points out that the Application specification does not discuss any UV light stabilizers, and the Topolkaraev et al. reference does not appear to discuss any polymer compatibilizers for its polymer mixture. Therefore, Applicant submits that the additional element of compatibilizer in dependent claim 6 also does not appear to be taught by Topolkaraev et al.

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Because the Topolkaraev et al. reference has not been shown to disclose all of the parameters or elements of the invention as claimed in claims 1-8 and 10-20, the Applicant submits that the rejection under 35 U.S.C. §102(e) over Topolkaraev et al. should be withdrawn.

For the reasons stated above, it is respectfully submitted that all of the claims are in form for allowance.

Please charge any prosecutorial fees which are due to Kimberly-Clark Worldwide, Inc. deposit account number 11-0875.

The undersigned may be reached at: 770-587-8908.

Respectfully submitted,

XIN NING

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CERTIFICATE OF FACSIMILE TRANSMISSION

I, Robert A. Ambrose, hereby certify that on October 31, 2005, this document is being faxed to the United States Patent and Trademark Office, central facsimile machine at (571) 273-8300.

By:


Robert A. Ambrose